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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte JOSHUA S. ALLEN, BRYAN M. ELLINGTON,
BRADFORD AUSTIN FISHER, ROBERT L. NIELSEN, and
JACOB YACKENOVICH

_____

Appeal 2009-012564
Application 10/675,726
Technology Center 2400

_____

Before ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge*,
ROBERT E. NAPPI, and BRADLEY W. BAUMEISTER, *Administrative
Patent Judges*.

BAUMEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. §§ 6(b) and 134 from the Examiner's rejection of claims 1-23. We affirm.

BACKGROUND

Appellants' invention relates to a service level management system for a computer network that "can track services provided to customers and compare the delivery of services to the service terms of a corresponding [contractual service level agreement] SLA" (Spec. 3). Creating an "SLA involves choosing the thresholds across which a breach of the SLA can be identified," and at the time of the invention, "SLA breach values [were] manually selected" (Spec. 3). Appellants' invention "addresses the deficiencies of the art in respect to establishing an SLA breach value and provides a novel an non-obvious method, system and apparatus for SLA breach value estimation" (Spec. 4).

Claims 1, 6, and 15 are the independent claims on appeal, respectively directed towards "[an SLA] breach value estimator," "a method for estimating [an SLA] beach value," and "[a] machine readable storage having stored thereon a computer program for estimating [an SLA] breach value." Independent claim 1 is illustrative, reading as follows:

> 1.   A service level agreement (SLA) breach value estimator comprising:
>   a communicative coupling to data produced for at least one resource; and,
>   a further communicative coupling to a user interface through which an SLA breach value estimate is proposed; and,
>   at least one SLA breach value estimation process selected from the group consisting of an aggregated process, a specific

customer process, a customer resource subset process, and a predictive process.

THE REJECTION UNDER 35 U.S.C. § 101

Claims 1-5 stand rejected under 35 U.S.C. § 101 as being directed towards unpatentable subject matter (Ans. 3, 8). With respect to this rejection, Appellants argue claims 1-5 together as a group (Br. 4). Accordingly, we select independent claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(1)(vii).

The Examiner notes that Appellants' Specification states, "'the present invention can be realized in hardware, software or a combination of both'" (Ans. 8 *citing* Spec. 12:3-4). The Examiner therefore finds that claim 1 is written broadly enough to be interpreted as being directed towards software per se and, accordingly, concludes that claim 1 is not directed to patentable subject matter (Ans. 8).

Appellants contend that the ordinary and customary definitions of the term coupling indicate that a communicative coupling is a device and that "the Examiner has <u>failed</u> to produce <u>any evidence</u> that the communicative coupling is 'an abstract idea or software'" (Br. 5-6).

Appellants additionally assert that the Examiner's position "that a claim must recite hardware elements to enable its functionality is not a proper statement of the law" (Br. 4). But rather, "if the claims, under a broadest reasonable interpretation, <u>could</u> require the use of a statutory subject matter (e.g., a computer, a device, a product, etc.), then the claims meet the requirements of 35 U.S.C. § 101" (*see* Br. 4-5, *citing In re Comiskey* (Appeal No. 2006-1286 (Fed. Cir. Sep. 20, 2007))).

Issues

Appellants' arguments present the following issues:

1. Did the Examiner err in interpreting the term "communicative coupling" as reading on software *per se*?

2. Did the Examiner err in concluding that a claim written broadly enough to be interpreted as being directed to software *per se* is subject to rejection under 35 U.S.C. § 101 for being directed to patent ineligible subject matter?

Findings of Fact

The record supports the following Findings of Fact (Facts) by a preponderance of the evidence:

1. Definitions for "coupling" include "*Elect.* a. the association of two circuits or systems in such a way that power may be transferred from one to the other. b. a device or expedient to insure this." *Webster's Encyclopedic Unabridged Dictionary of the English Language*, p. 334 (1989).

2. Appellants state that "[t]he present invention can be realized in hardware, software, or a combination of hardware and software" (Spec. 12:3-4).

Principles of Law

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the Specification. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004); *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969).

It is the Appellants' burden to precisely define the invention, not the USPTO's. *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997). Appellants always have the opportunity to amend the claims during prosecution, and

broad interpretation by the Examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969).

A patent claim must be limited so as to exclude covering nonstatutory subject matter in order to avoid a rejection under 35 U.S.C. § 101. *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1329 (Fed. Cir. 2003).

Analysis

The Examiner did not err in interpreting the term "communicative coupling" as reading on software per se. Appellants acknowledge that a coupling may be a device, a means of connecting, or a common part (Br. 5-6). A coupling may be additionally defined as "an association" or "an expedient to insure [that power may be transferred between electrical components]" (Fact 1). Appellants' Specification provides no express definition for the term "communicative coupling," and the Specifications' usage of the term "communicative coupling" (*see, e.g.*, Spec. 4, 8-9) does not exclude any of these potential common definitions. Moreover, Appellants have provided no rationale for why it would be improper to interpret software per se as any one of a device, a means of connecting, a common part, or an expedient to insure the transfer of electrical signals between electrical components. Rather, and as noted by the Examiner (Ans. 8), Appellants' Specification expressly states that "[t]he present invention can be realized in hardware, software, or a combination of hardware and software" (Fact 2). As such, we see no error in interpreting a "communicative coupling" as reading on software that either (1) gathers data that is produced for a resource, or alternatively (2) forwards breach value estimates to an appropriate user interface.

5

Turning to claim 1 as a whole, the Specification does not define what structure must be associated with an SLA breach value estimator (*see generally*, Spec.). Moreover, Appellants have not alleged that the term "estimator" denotes any commonly understood structure, much less have they provided any evidence in support of such an allegation (*see generally*, Br.). Nor have Appellants disputed that the last limitation, which is directed to "at least one SLA breach value estimation process," may be reasonably interpreted as reading on software per se. As such, the Examiner's interpretation that claim 1 reads on software per se is a reasonable one.

We now turn to the issue of whether the Examiner erred in concluding that a claim written broadly enough to be interpreted as being directed to software *per se* is subject to rejection under 35 U.S.C. § 101 for being directed to patent ineligible subject matter? We agree with the Examiner that a rejection under 35 U.S.C. § 101 is proper for such claims. Regardless of how Appellants may be interpreting various statements made by the Court of Appeals in *Comiskey* (*see* Br. 4-5), the law is clear that a patent claim that is broad enough to cover both statutory subject matter and nonstatutory subject matter is subject to rejection under 35 U.S.C. § 101. *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d at 1329.

For the foregoing reasons, we find that the Examiner did not err in rejecting representative claim 1 under 35 U.S.C. § 101 as being directed to patent ineligible subject matter. Accordingly, we will sustain the Examiner's rejection of that claim as well as claims 2-5 which depend from claim 1.

THE REJECTION UNDER 35 U.S.C. § 102(e)

Claims 1-23 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Betge-Brezetz (US 2005/0177629 A1) (Ans. 3-11). With respect to this rejection, Appellants argue claims 1 and 5-23 together as a first group, dependent claim 2 individually as a second group, and dependent claims 3 and 4 together as a third group (Br. 6). Accordingly, we select independent claim 1 as representative of claims 1 and 5-23, and we select claim 3 as representative of dependent claims 3 and 4. *See* 37 C.F.R. § 41.37(c)(1)(vii).

CLAIM 1

Appellants note that claim 1 recites "a further communicative coupling to a user interface through which an SLA breach value estimate is proposed" (Br. 8), and they argue that the concept of a breach value estimate is absent from Betge-Brezetz (Br. 8-11). Appellants also argue that they are unclear as to where the cited prior art teaches at least one SLA breach value estimation process (Br. 10). More specifically, Appellants argue that the parameter estimates referred to in paragraph [0049] of Betge-Brezetz are in relation to a service level agreement usage predictive profile, but that these parameters being estimated are not disclosed as being SLA breach values. Rather, "these parameters are used to '[predict] customer requirements in terms of resources and/or services'" (Br. 10-11).

Appellants further argue that the Examiners anticipation rejection fails to comply with 37 C.F.R. § 1.104(c) because the Examiner has failed to clearly identify how the prior art's elements correspond to the individual claim elements (Br. 8). However, any question of whether the Examiner has complied with the requirements of 37 C.F.R. § 1.104(c) is not a matter

properly considered by the Board of Appeals and Interference in an appeal under 35 U.S.C. § 134.

Issues

Appellants' arguments, then, raise the following issues:

1.   Does Betge-Brezetz disclose a communicative coupling to a user interface through which an SLA breach value estimate is proposed?

2.   Does Betge-Brezetz disclose at least one breach value estimation process?

Additional Findings of Fact

3.   [Betge-Brezetz's] invention allows the network manager to define better the terms of the service level agreements (SLA) that it has to enter into with its future customers, taking account of the existing network, and the terms of the service level agreements that it must enter into with its future customers after the network has been modified. . . .
      [T]he invention can also be used in the service creation and service offer phase effected by the operator of the network. Instead of varying the configuration of the existing network, it is possible to vary the definitions of the service level agreements to optimize the definitions of the service level specifications that can be supported by the existing network.

(¶¶ [0078], [0081]).

4.   Betge-Brezetz's processing system 1 includes a graphical user interface 5 that includes first and second display modules 10, 15 (e.g., ¶¶ [0045], [0051], and [0063]; Fig. 2).

Analysis

Under at least one reasonable claim interpretation, Betge-Brezetz does disclose a communicative coupling to a user interface through which an SLA breach value estimate is proposed.

Appellants contend that claim 1 is directed to a device, as opposed to a process, and that a communicative coupling is also a device (Br. 4). Even accepting Appellants' position, though, the Specification still fails to expressly define or limit what devices may constitute a "communicative coupling." As such, it is reasonable to interpret this claim term as reading on any electrical communication means (e.g., cable, wire, bus, or trace), as well as, for example, any wireless, optical, or audible communication means, for transmitting information or electrical signals from one component to another (*see* Fact 1).

The claim limitation further requires that one end of this communicative coupling be "to a user interface." The rest of the claim limitation, "through which an SLA breach values estimate is proposed," recites the use intended for the claimed structure. However, nothing in claim 1 affirmatively sets forth any structure that accepts the breach value estimate (or data). Nor does claim 1 affirmatively recite any structure that links this data to any component that is capable of performing the subsequently recited "at least one SLA breach value estimation process." As such, the limitation "a further communicative coupling to a user interface through which an SLA breach value estimate is proposed" merely reads, for example, on a cable for various data input components that are capable of proposing SLA breach value estimates. That is, the contested limitation reads on, *inter alia*, a cable for a computer keyboard or mouse.

In that Betge-Brezetz discloses a communication network (*e.g.*, Abstract), one of ordinary skill in the art would understand Betge-Brezetz as implicitly disclosing the presence of computer keyboards and other user-interface input devices for the network. One of ordinary skill would further

understanding that such input devices have associated means, such as electrical cables, for communicatively coupling these input devices to the network. *See In re Preda*, 401 F.2d 825, 826 (CCPA 1968) (noting that "in considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom").

We now turn to the last limitation of claim 1 and the issue of whether Betge-Brezetz discloses at least one SLA breach value estimation process. We find that it does.

Appellants' Specification refers to a "SLA breach value estimation process" in reference to a process for estimating or automatically selecting SLA breach values. However, the Specification does not expressly define or limit what is meant by the term "SLA breach value estimation process." Under the broadest reasonable interpretation, then, an SLA breach value estimation process could be interpreted to read on a process that employs SLA breach value parameters as data inputs for estimating other results, such as future network hardware or service requirements.

Appellants acknowledge that Betge-Brezetz generates a service level agreement usage predictive profile that estimates parameters for "'[predicting] customer requirements in terms of resources and/or services'" (Br. 10-11, *citing* Betge-Brezetz ¶ [0050]). That is, Betge-Brezetz predicts resource requirements based upon an analysis of service level agreement breach values. As such, the term "SLA breach value estimation process" of claim 1 is broad enough to read on the network planning proposal process of Betge-Brezetz.

10

Furthermore, even if "SLA breach value estimation process" is interpreted more narrowly as only meaning a process for estimating or SLA breach values, Betge-Brezetz still anticipates claim 1. Betge-Brezetz additionally states that such a process is an additional aspect of the invention (*see* Fact 3).

Claim 2

Claim 2 depends from claim 1 and further recites that "the estimator [of claim 1] is disposed within an SLA builder." Appellants allege that the Examiner is mischaracterizing the teachings of Betge-Brezetz in finding "that Betge-Brezetz 'discusses future service level agreements that will [be] created for future customers'" (Br. 12). The issue, then, is: does Betge-Brezetz discloses that it's system of configuring a communication network further creates or "builds" future service level agreements?

Appellants have not alleged that the term "SLA builder" has any art-recognized meaning (*see generally*, Br. 11-12). Nor does Appellants' Specification express define either what structural components constitute an SLA builder or what minimum functions an SLA builder must perform. Instead, the Specification generally sets forth that an SLA builder 110 is "configured to generate an SLA 130 based upon the performance of one or more resources 144" (Spec. 4). We understand, then, that an SLA builder can either be (1) fully automated, so as to automatically gather all requisite data and create or "build" an SLA without a human operator manually entering any data, or (2) partially automated, so as to create an SLA after a human operator manually enters at least some data into the computer.

Betge-Brezetz discloses that the invention can be used to create future service level agreements, (Fact 3). As such, the Examiner reasonably found that Betge-Brezetz's system constitutes or includes an SLA builder.

Claim 3

Dependent claim 3 states that "[t]he SLA breach value estimator of claim 1[ ] further compris[es] a graphical user interface *configured to render a chart of resource data over time derived from said produced data along with an indication of a current SLA breach value setting and a proposed SLA breach value setting*" (emphasis added). Appellants do not dispute that Betge-Brezetz discloses a graphical user interface (Br. 12-13). Rather, Appellants argue that the prior art's references "to future service level agreements do not inherently establish that these passage refer to a current SLA breach value setting and a proposed SLA breach value" (id.).

We need not decide, though, whether Betge-Brezetz's system actually renders a chart of resource data over time based upon, inter alia, current and proposed SLA breach value settings. The claim term "graphical user interface" reads on a computer monitor. The italicized portion of the claim language that follows "graphical user interface" (see *supra*) is directed towards the intended use of the graphical user interface. But claim 3 does not further recite any components (e.g., hardware or software) that actually cause the data to be rendered on the graphical user interface. That is, claim 3 only requires that the SLA breach value estimator of claim 1 further comprises a computer monitor that is capable of rendering the recited chart of resource data. *See, e.g., Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990) (noting "apparatus claims cover what a device is, not what a device does").

Turning to the cited art, Betge-Brezetz's processing system 1 includes a graphical user interface 5 that includes first and second display modules 10, 15 (Fact 4). Appellants do not dispute this fact. Nor do Appellants question whether Betge-Brezetz's graphical user interface, if provided with the appropriate computer instructions and data, would be *capable of* rendering a chart or resource data over time that is derived from produced data along with an indication of current and proposed SLA breach value settings. Accordingly, we sustain the Examiner's rejection of representative claim 3 as well as claim 4 which depends from claim 3.

DECISION

The Examiner's decision rejecting claims 1-23 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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